

REMARKS

General:

Claims 1-14 are pending in the application. Claims 1-14 are rejected. Claims 1, 6, 10, and 11 are amended.

The main amendments to claims 1 and 11 are discussed below. The opportunity has also been taken to refine the wording of claims 1 and 11 to eliminate some passages of text that the examiner appears to have misunderstood.

For stylistic reasons, the expression “client information” has been adopted throughout the claims in preference to “client data.”

The amendment to claim 6 makes explicit that “new business information” is “information relating to new business” and not merely “new information relating to business.”

No new matter is added by this amendment.

Claim rejections – 35 USC § 103

Claims 1-14 were rejected as obvious over U.S. Patent No. 6,526,386 (Chapman et al.) in view of U.S. Patent No. 6,519,5678 (Harvey et al.)

Chapman shows a system for generating motor insurance renewal certificates FH1 and cancellation certificates FH4, in which a database 128, 132 of current insurance policies is maintained centrally. Renewal or cancellation information is entered remotely by an insurance agent 102 or by a finance company 208. Certificates or reports FHI, FH4, 110 may be printed centrally, or data for the printing of certificates or reports may be sent by the central office 122, 138 to one of the remote terminals, where a form processing and printing procedure 115, 116 is run locally.

Harvey shows a system and method for collecting, collating, and distributing large quantities of data from oil well wireline logging.

The present invention, as claimed in claim 1, provides a system for inputting and collecting insurance information from a plurality of remotely connected agents, said system comprising: a forms database, said forms database including completed insurance forms; a

network server providing access to said forms database from a plurality of remotely located terminals; a data transfer server; and a formatting computer receiving individual client data and formatting forms with said received individual client information, completed forms being provided to said data transfer server.

The examiner contends that the databases 128 and 132 of Chapman constitute “a forms database, said forms database including completed insurance forms.” However, there is no disclosure or suggestion in Chapman that the databases 128 and 132 include completed forms. There is no disclosure or suggestion in Chapman that the databases 128 and 132 contain anything other than data in a database format.

In subsection (B) on pages 7 and 8 of the office action, the examiner points to Chapman’s definition of a “file” as including “data relating to a particular matter, such as a particular insurance policy or insured” (col. 3, line 17-21). The examiner also points to Chapman’s “policy status database 128” and “main database 132 containing data relating to main systems 134” where main systems 134 are systems “relating to other aspects of the insurance carrier’s business, such as underwriting and claims handling” (col. 4, lines 6-13). The examiner then asserts that “the files, which are stored in databases, include completed insurance application forms since renewal and cancellation forms are generated from completed insurance applications that produce insurance policies.” It is unclear whether the examiner has overlooked the distinction between inputting data and inputting and storing actual forms, or whether the examiner is interpreting “forms” so broadly as to include a data structure in a computer file. In subsection (C) on page 8, the examiner seems to be arguing that “data that is formatted” is the same as “forms.”

With all due respect to the examiner, that is not, in the context of the present invention (or for that matter the context of Chapman), a proper or even reasonable interpretation of “forms.” The claims must be interpreted in the light of the description, and the description repeatedly describes that “data is entered into insurance industry standard forms,” page 4, lines 20-21, “completed forms may be compressed into a single file,” page 5, lines 16-17, and the forms are provided as e.g., a bitmap, pdf, or jpeg image file, page 6, lines 18-19. These, and numerous similar remarks, would leave the skilled reader in no doubt that the “forms” referred to are not mere abstract constructs of formatted data, but are forms in the strict sense, of something having at least the appearance of a paper document with specific information in specific

positions. The skilled person would understand that much of the insurance industry is very conservative, and that the adherence to at least the appearance of a traditional form, and preferably a standard form such as the ACORD forms mentioned in the specification, is deliberate. In order to make this explicit, claims 1 and 11 have been amended to refer to “human-readable forms.”

There is no disclosure or suggestion in the cited references of processing actual completed forms, as required by the present invention.

In section (C) the examiner further contends that “a remote computer ... as described by Chapman would read on the claim.” The surrounding argument does not support that assertion, but attempts to show that Chapman’s remote computer corresponds to the formatting computer of claim 1. However, the examiner makes no showing that the remote computers of Chapman provide data to components corresponding to the other elements of claim 1. In order to make the distinction more immediately apparent, claims 1 and 11 have been amended to recite explicitly that the formatting computer provides completed forms to the forms database. There is no suggestion in Chapman that the remote computers provide completed forms to a forms database: in Chapman, forms are generated only for printing.

Harvey does not remedy the above deficiencies, and it is therefore submitted that the present invention, as claimed in claim 1, was not obvious over a combination of Chapman and Harvey.

The examiner acknowledges that Chapman does not have a data server, but repeats his earlier assertion that it would have been obvious to include Harvey’s data server in Chapman’s system “with the motivation of providing a system that offers seamless delivery of real-time data from acquisition sites to delivery sites with an integration of all data streams.” As pointed out in applicant’s previous response, Chapman does not have “real-time data from acquisition sites” that need to be delivered “seamlessly,” and does not have “data streams” to be “integrated.” The Examiner has used the benefits of the present invention as the basis for teaching the combination. This is clearly impermissible under the law. The present invention cannot be used as the launching pad for the assembly of the prior art. There must be some motivation established outside the present application as the basis for the combination. None has been shown.

It is respectfully submitted that the prior response fully addressed the flaw in the examiner’s basis for claiming there is motivation to modify Chapman. It is respectfully

submitted that the current office action does not even attempt to reply to the points raised by the Applicant. Thus, Applicant's position stands and is incorporated herein by reference. Thus, for all the reasons set forth in Applicant's previous response, it would not have been obvious to combine Chapman and Harvey as the examiner proposes.

The examiner's remarks on the law of obviousness in section (D) of the office action have been carefully considered but, in the absence of appropriate factual basis in the prior art references, do not appear to assist the examiner in attempting to establish a prima facie case of obviousness.

Claims 2-10 are dependent from claim 1 and claims 12-14 are dependent from claim 11 and, without prejudice to their individual merits, are deemed non-obvious over Chapman and Harvey for the same reasons as their respective base claims.

In addition, however, with reference to claim 3, as explained in the application at page 7, lines 12-15, an FTP server is most appropriate for very large files, such as page images of multi-page documents. That is even less appropriate for Chapman's systems, and the reasons for non-obviousness set out above apply even more strongly to claim 3 than they do to claim 1. The examiner has not even addressed applicant's prior argument. Hence, it would appear that Applicant's prior argument holds and claim 3 should be allowable.

With further reference to claims 3 and 12, the examiner asserts that "data relating to automobile insurance policies" reads on "completed insurance applications." It is respectfully pointed out that an *application* for insurance is different from an issued *policy*. It is highly unlikely that Chapman's database of existing policies will contain the same information that is required in an *application* for insurance. The examiner asserts that Chapman's data files "include completed insurance application forms since renewal and cancellation forms are generated from completed insurance applications that produce insurance policies." A database sufficient to generate a renewal or cancellation will not necessarily, or even usually, contain all the information from a completed insurance application, and the examiner's rejection is traversed. In addition, the examiner makes no attempt to show that Chapman's database contains actual completed applications as required by claim 3 and 12. The Examiner is reading much into Chapman that is simply not there. A reference can be used only for what it discloses or suggests

to a person of ordinary skill in the art. The Examiner has taken tremendous liberty in interpreting Chapman to the point that it is much larger than life. It is respectfully submitted that such an interpretation is not proper.

With reference to claims 3, 4, 5, 12, and 13, in Chapman's system the printing of certificates is either instigated by the central office 122, 138 or part of an interactive session between the central office 122 and the remote agent 102. It would not be appropriate to use an FTP server or e-mail server for sending out the print jobs, because both those sorts of data transfer server require a separate intervention by the remote agent to transfer the files to the print process 116, 118. Harvey discloses e-mail and FTP data servers for Harvey's purpose, but there is no motivation to introduce them into Chapman's system because they are inappropriate for Chapman's purpose. This point was set forth in the prior response and that examiner has not responded to applicant's argument.

With reference to claim 6, the examiner appears to rely on reading "new business information" as "new information about existing business." It should have been clear from the application as a whole that was not what the phrase meant. However, to clarify the claim, the syntax of claim 6 has been refined to explicitly exclude the examiner's interpretation.

With reference to claim 7, the examiner argues that Chapman's remote computer terminals provide "image generation means ... generating images of insurance policy forms" as required by claim 7. However, Chapman's remote computer terminals do not have the other features of the image generation means recited in claim 7. In particular, Chapman does not have compression means for compressing the images, nor any way of transferring the resulting files to the forms database and data transfer server. There is no disclosure or suggestion in the cited prior art of the system claimed in claim 7.

With reference to claims 8 and 14, there is no disclosure or suggestion in Harvey of "compressed files below a selected size being e-mailed over said e-mail server to a registered agent, said compressed file being included with said e-mail and, compressed files exceeding said selected size being stored on said FTP server" as required by claim 8. The examiner argues that Harvey provides an FTP server 122 and a notification server 123 that sends e-mail with optional attachments. However, which server to use is a choice for the user, see col. 18, lines 39-43, because different users have different needs and preferences, see col. 2, lines 22-40. The passage

beginning “This indicates” at page 12, lines 5-9 of the office action asserts features that are not disclosed or suggested by Harvey. Hence, in light of the above, it is respectfully submitted that the rejection is traversed.

With regard to claim 9, the forms shown in Figs. 9 and 10 of Chapman are not insurance policy application forms or contact forms, as recited in claim 9, they are cancellation notices and renewal policies, see col. 7, lines 1-5. The forms shown in Figs. 9 and 10 of Chapman are not stored on a forms database or delivered through a data transfer server. The forms shown in Figs. 9 and 10 of Chapman are generated by print processes 116, 118 local to the printer. There is no disclosure or suggestion in Chapman of compressed image files of insurance policy forms being stored on said forms database and provided to said data transfer server “wherein said insurance policy forms include insurance policy application and contact forms” as required by claim 9.

With regard to claim 10, the examiner asserts that Chapman “teaches the claimed client data includes insurance policy application and contract data.” While claim 10 does not enumerate the specific data, it is believed to be clear, when claim 10 is properly interpreted in the light of the specification, that the “insurance policy application and contract data” are data providing sufficient information that includes whatever is necessary to generate a complete application form and contract form. There is no suggestion that Chapman’s database contains the necessary information. An application for insurance commonly requires a lot of information that would not be necessary for a system like Chapman’s that merely has to monitor the status of existing policies.

For these reasons also, claims 3-10 and 12-14 are deemed non-obvious over Chapman and Harvey.

Claim 11 is further deemed patentable for at least the reasons given above in respect of claims 6, 7, and 9.

Conclusion:

In view of the foregoing, reconsideration and withdrawal of the examiner's objections and rejections, and allowance of all of claims 1-14, is earnestly solicited.

Respectfully submitted,

THOMAS EDWARD PEACH

By:

A handwritten signature in black ink, appearing to read 'Robert E. Cannuscio', written over a horizontal line.

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